

REMARKS

Upon entry of this Response, claims 1-4, 7-8, 10-25, 27-29, and 31-40 remain pending in the present patent application. Claims 1, 14, 24, 27, and 31 have been amended, and claims 6, 9, and 30 have been canceled herein. Applicants respectfully request reconsideration of the pending claims in view of the following remarks.

Claims 1-9, 12-19, 21-23, 31-34, and 36-38 have been rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent 4,822,025 issued to Chung (hereafter "*Chung*"). Anticipation under §102 "requires the disclosure in a single prior art reference of each element of the claim under construction." W.L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303, 313 (Fed. Cir. 1983). Claims 6 and 9 have been canceled herein, thereby rendering this rejection moot with respect to such claims. For the reasons that follow, Applicants assert that *Chung* fails to show or suggest each of the elements of these claims. Accordingly, Applicants request that the rejection of these claims be withdrawn.

To begin, claim 1 as amended recites as follows:

1. An apparatus for distributing print media comprising:
an accumulator pivotable about an axis, the accumulator having a print media inlet and a print media outlet;
the accumulator being configured to accumulate a plurality of sheets of a print media;
a belt having a protrusion that transports the print media out of accumulator through the print media outlet; and
an actuator configured to pivot the accumulator about the axis.

With respect to original claim 1, the Office Action states:

Regarding claims 1-3, 5, 12-19, 21-22, 31-32, 34, 37, Chung (Fig. 1-6) teaches a printing apparatus for distributing print media comprising
an image-forming device (Fig. 2),
at least one input roller (Fig. 3, near 1) that transports the print media to a staging location (sheet supporting surface in 2) the accumulator,
an accumulator (guide 2; col. 3, ln. 23-32 wherein side brackets are capable of registering sheets during the pivoting movement) pivotable about an axis (8), the accumulator having a print media inlet (right fig. 4) and a print media outlet (left near trays in fig. 4),
an actuator (motor 6) configured to pivot the accumulator about the axis, and

a first output bin and a second output bin aligned to receive print media discharged from the accumulator; and the first output bin and the second output bin are stationary relative to the axis (Fig. 3-6, first and second bin can be regarded as any adjacent output trays). Further, Applicant is respectfully reminded that claim language consisting of functional language and/or intended use phrasing is given little, if any, patentable weight as the apparatus must merely be capable of functioning, or being used, as claimed. See MPEP 2112.02, 2114. Here, the accumulator taught by Chung is certainly capable of accumulating a plurality of sheets of a print media.

Office Action, pages 2-3. Applicants respectfully disagree. In particular, the statement that “an accumulator (guide 2; col. 3, ln. 23-32 wherein side brackets are capable of registering sheets during the pivoting movement) pivotable about an axis (8), the accumulator having a print media inlet (right fig. 4) and a print media outlet ...” is simply incorrect. The guide 2 recited as an accumulator in the Office Action is merely a device that establishes a paper path and does not serve as an accumulator.

In particular, reference is made to Figures 4 and 5 of *Chung*. As seen, paper flows through two rollers at the right of both drawings and slides along an upper surface of the guide and is ultimately grabbed by the two “paper-feeding rollers” 3 and 4. Essentially, the paper path provided by the guide 2 provides for the distribution of documents amongst the various bins 17.

The guide 2 is not an accumulator that accumulates sheets of paper for several reasons. First, if paper is to be accumulated on the guide 2, then the paper would have to leave the input rollers and rest on the accumulator before being grabbed by the paper-feeding rollers 3 and 4 to drive the paper into a given bin 17. If paper were to be accumulated on the guide 2, then there would be no mechanism to cause the paper to be moved to the bin 17. Specifically, if paper rested between the input rollers and the paper-feeding rollers 3 and 4, then when the time came to shove the paper into one of the bins 17, there would be no mechanism to move the stack of papers forward since the rollers 3 and 4 are stationary.

In addition, the rollers 3 and 4 clamp together on a given sheet of paper being shuttled to a given bin 17. If a stack of papers was fed through these rollers, in all likelihood, they would jam since the rollers 3 and 4 are stationary. As such, they would pinch the stack and cause a jam or other malfunction.

Furthermore, the guide 2 includes an upper shield that ensures the leading edge of the paper is shuttled in the right direction toward the paper feeding rollers 3 and 4. If a stack of papers was to be built up on the guide 2, this shield would ultimately interfere once the stack became larger than the shield. Thus, the assertions in the Office Action that the paper guide 2 teaches an accumulator as claimed herein is based on a misinterpretation of *Chung*.

In addition, Applicants note that the Office Action states as follows:

Further, Applicant is respectfully reminded that claim language consisting of functional language and/or intended use phrasing is given little, if any, patentable weight as the apparatus must merely be capable of functioning, or being used, as claimed. See MPEP 2112.02, 2114. Here, the accumulator taught by *Chung* is certainly capable of accumulating a plurality of sheets of a print media.

Office Action, pages 2-3. Applicants respectfully disagree. The element of the "accumulator being configured to accumulate a plurality of sheets of print media" is not a mere functional element, but imparts structural aspects of the accumulator. In this respect, the accumulator is mechanically adapted so as to accumulate a plurality of sheets of print media. Thus, the language serves to more precisely define the structural attributes of the accumulator. Such elements deserve proper consideration during patentability proceedings. See MPEP §2173.05(g); *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); *Ex parte Conner*, 215 USPQ 384 (PTO Bd. App. 1981). Accordingly, the statement in the Office Action that such an element is to be given little patentable weight is incorrect.

In addition, claim 1 has been amended herein to recite that "a belt having a protrusion that transports the print media out of the accumulator through the print media outlet." Applicants assert that *Chung* fails to show or suggest such a belt. In particular, *Chung* describes a motor 9 that drives the paper-feeding rollers 3 and 4 via a belt 10. The belt 10 that exists between the rollers 3 and 4 and the motor 9 does not come into contact with the paper since the paper slides along the top of the guide 2. Thus, there is no belt shown or described by *Chung* that transports the print media out of the accumulator through the print media outlet. Rather, the print media 1 slides through the

guide when pushed by the input rollers and is then grasped between the rollers 3 and 4 and thrust out into an appropriate bin 17.

Mindful of the significant burden that each and every element of a claim must be disclosed in a given reference in order to effect a rejection under § 102, Applicants assert that *Chung* fails to anticipate each and every element of claim 1 as amended as set forth above. Accordingly, Applicants request that the rejection of claim 1 be withdrawn. In addition, Applicants request that the rejection of claims 2, 3, 5, 12, and 13 be withdrawn as depending from claim 1. In addition, Applicants request that the rejection of claims 14 and 31 as amended be withdrawn for reasons described above with respect to claim 1 to the extent they apply. Also, Applicants request that the rejection of claims 15-19, 21-22, 32, 34, and 37 be withdrawn as depending from claims 14 or 31.

Next, claims 1-5, 12-17, 20-25, and 27-29 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent 4,431,178 issued to Kokubo et al. (hereafter "*Kokubo*"). Anticipation under §102 "requires the disclosure in a single prior art reference of each element of the claim under construction." W.L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303, 313 (Fed. Cir. 1983). For the reasons that follow, Applicants request that the rejection of these claims be withdrawn.

Once again, claim 1 as amended recites as follows:

1. An apparatus for distributing print media comprising:
an accumulator pivotable about an axis, the accumulator having a print media inlet and a print media outlet;
the accumulator being configured to accumulate a plurality of sheets of a print media;
a belt having a protrusion that transports the print media out of accumulator through the print media outlet; and
an actuator configured to pivot the accumulator about the axis.

As set forth above, claim 1 has been amended so as to recite a belt having a protrusion that transports the print media out of the accumulator through the print media outlet. In this respect, claim 1 recites a structure that provides for the effective pushing of one or more sheets of print media into an appropriate bin. Given that the whole belt moves,

the print media does not get caught up on stationary structures along which it might come into contact.

Applicants assert that *Kokubo* fails to show or suggest such an element. In particular, with reference to the drawing of Figure 1, *Kokubo* shows a carrier plate 7 that pivots to dump bank notes into a reject bin 9. When the carrier plate pivots, a downward slope is created such that bank notes presumably slide down the carrier plate 7 and into the reject bin 9. There is no belt shown that includes a protrusion that transports a print media out of an accumulator through the print media outlet.

Accordingly, Applicants assert that *Kokubo* fails to show or suggest each of the elements of claim 1 as amended. In addition, Applicants assert that *Kokubo* fails to show or suggest each of the elements of claim 14 as amended for the same reasons described above with respect to claim 1 as amended to the extent they apply. In addition, Applicants request that the rejection of claims 2-5, 12-13, 15-17, and 20-23 be withdrawn as depending from claims 1 or 14.

In addition, claim 24 has been amended to incorporate the subject matter of claim 30, which was objected to as being dependent upon a rejected base claim, but was indicated as being allowable if rewritten in independent form, including all the limitations of any base claim and any intervening claims. Claim 30 previously depended from claim 24. Accordingly, Applicants assert that claim 24 is in condition for allowance. Therefore, Applicants request that the rejection of claim 24 be withdrawn. Claim 30 has been canceled herein, rendering the objection to claim 30 moot. Further, Applicants request that the rejection of claims 25 and 27-29 be withdrawn as depending from claim 24.

Next, claims 6, 9, 10, and 35 have been rejected under 35 USC §103(a) as being unpatentable over *Chung* in view of US Patent 3,356,362 issued to Mestre (hereafter "Mestre"). A prima facie case of obviousness is established only when the prior art teaches or suggests all of the elements of the claims. MPEP §2143.03, In re Rijckaert, 9 F.3d 1531, 28 U.S.P.Q2d 1955, 1956 (Fed. Cir. 1993). Given that claims 6 and 9 have been canceled herein, this rejection is moot with respect to such claims. In addition, Applicant asserts that the cited combination of references fails to show or suggest each of the elements of these claims as depending from claims 1 or 31 for the reasons

described above. Accordingly, Applicant requests that the rejection of claims 6, 9, 10, and 35 be withdrawn.

Next, on page 6, claims 11, 20, 29, and 39-40 have been rejected under 35 USC §103(a) as being unpatentable over *Chung* in view of US Patent 5,382,012 issued to Mandel (hereafter "*Mandel*"). A prima facie case of obviousness is established only when the prior art teaches or suggests all of the elements of the claims. MPEP §2143.03, In re Rijckaert, 9 F.3d 1531, 28 U.S.P.Q2d 1955, 1956 (Fed. Cir. 1993). Applicant asserts that the cited combination of references fails to show or suggest each of the elements of claims 11, 20, 29, and 39-40 as depending from claims 1, 14, 24, or 31 for the reasons described above. Accordingly, Applicant requests that the rejection 11, 20, 29, and 39-40 be withdrawn.

Also, in the Response to Arguments on page 7 of the Office Action, it is stated that "Applicant is respectfully reminded that claim language is interpreted as broadly as reason allows and that it is not unreasonable to interpret the guide taught by *Chung* as an accumulator as the guide of *Chung* is certainly capable of functioning as an accumulator of several sheets." Applicants assert that this statement is clearly wrong. The guide of *Chung* is not capable of functioning as an accumulator of several sheets for the reasons described above.

In addition, if the Examiner feels that a conference with the undersigned attorney of Applicant would expedite the prosecution of the present case, the Examiner is invited to call the undersigned.

CONCLUSION

It is requested that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding this Response, the Examiner is encouraged to telephone the undersigned counsel of Applicants.

Respectfully submitted,

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